

REMARKS

Claims 2, 11-13 and 54-85 are pending in this application and stand rejected.

Claims 2, 12, 54-58, 60-64, 66, 68-72, 78, 79 and 81-85 have been amended. Claims 54, 71 and 84 are independent.

This Amendment is filed subsequent to a telephonic interview conducted with the prior Examiner, Mr. Charles Kyle, on June 22, 2006. Applicant expresses appreciation for that interview. In general, this Amendment has been prepared in accordance with the discussion between the prior Examiner and Applicant's undersigned attorney during that interview.

Although not mentioned during the June 22 telephonic interview, Applicant submits herewith the Declaration Under 37 C.F.R. § 1.131 of Keiichi Nakajima, to antedate a cited reference, as explained below.

Applicant has determined that there are errors in the priority information contained in the Patent and Trademark Office's PAIR record for this application. Correction of those errors is requested, as explained below.

The Rejection Under
35 U.S.C. § 112, ¶ 2

Claims 2, 11-13 and 54-85 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter of Applicant's invention. In particular, the Office Action said that the language "being connectable" in claim 54, "synchronizing" in various claims, "setting up a transaction" in various claims" and "instructed" recited in claims 69, 70, 82 and 83 was unclear. Also, certain features were said to lack antecedent bases.

As explained in detail below, the rejected claims have been carefully reviewed and, where appropriate, have been revised to attend to these points.

The term "being connectable" has been cancelled; suitable new language has been used.

As regards the term "synchronizing", independent claims 54, 71 and 84 have been revised to use instead the term --mediating--. Support for this change can be found throughout the application as filed, in particular, at page 27, line 14-16 ("[t]he synchronizing server 30, which communicates with both the cashier terminal 10 and the user terminal 20, mediates the authentication processing"), page 36, lines 32-33 ("the synchronizing server 30 intermediates the authentications"), and page 43, lines 15-17 ("the synchronizing server 30 intermediates the authentication between the user terminal 20 and the cashier terminal 10"). Support also can be found in Fig. 1 (server 30 is connected to the cashier terminal 10 and user terminal 20 through different signal paths), and at pages 23-25.

It also should be noted that these claims provide for the use of authentication information to verify the identity of the user. Claim 54, 71 and 84 state that the mediating server (or processing module) which mediates communication between the paying and billing terminals sets an authentication method, and one of the mediating server (or processing module) and the billing terminal authenticates the user by using the authentication information stored in the paying terminal database. It will be appreciated that the mediating server/processing module is involved with the verification of the user's identify. These changes are made without conceding the propriety of the rejection on grounds "synchronizing" is unclear. Further, the scope of the claims has not been altered.

As regards the language "setting up a transaction", the only claims which used such language were claims 54 and 71. Those claims have been amended to use other language that is not deemed to raise any issues.

Various other points noted in the Office Action have been resolved - alternative language has been rectified, the unclear term "instructed" has been changed to --invoked--, and issues of antecedent basis have been corrected.

For all the foregoing reasons, favorable reconsideration and withdrawal of this rejection are respectfully requested.

The Rejection Under
35 U.S.C. § 102(e)

Claims 54, 71 and 84 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent Appln. Publn. No. 2002/0073046 to David. Applicant respectfully traverses this rejection, and submits the following arguments in support thereof.

David is a continuation-in-part of appln. no. 09/500,601, which in turn claims the benefit of two provisional applications, nos. 60/167,352 and 60/146,628, respectively filed on November 24, and July 30, 1999. Since David is a continuation-in-part, not all portions of David may be entitled to the filing date(s) of those earlier applications.

As the prior Examiner requested during the telephonic interview of June 22, 2006, copies of both those provisional applications are being submitted in the Information Disclosure Statement filed herewith.

Applicant respectfully submits that the present invention was made prior to David's earliest effective filing date, July 30, 1999.

To establish that Applicant made his invention before David's earliest effective filing date, a Declaration Under 37 C.F.R. § 1.131 is submitted herewith.

Consequently, even if the portions of David which the Office Action contends are supported by David's earliest benefit application, the present invention was made prior to the date of that benefit application.

Applicant therefore has sworn back of the reference, and so the rejection based upon David should be withdrawn.

Favorable reconsideration and withdrawal of these rejections are respectfully requested.

The Rejections Under
35 U.S.C. § 103(a)

Claims 4, 11-13, 55-60, 64-68, 72-74, 76 and 79-81 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over David in view of U.S. Patent No. 6,332,133 to Takayama.

Claim 56 has been rejected under 35 U.S.C. § 103(a) as being unpatentable over David in view of Takayama and further in view of U.S. Patent No. 6,282,522 to Davis et al.

Claims 56-68, 72-74, 76 and 79-81¹ have been rejected under 35 U.S.C. § 103(a) as being unpatentable over David in view of Takayama and further in view of U.S. Patent No. 6,282,522 to Davis et al.

¹ Although this section of the Office first states at page 7 only that claim 56 has been rejected, the subsequent portion of the rejection refers to claims 57-68, 72-74, 76 and 79-81. Accordingly, it is understood these claims all are rejected over David, Takayama and Davis. If, however, that is not correct, clarification is respectfully requested.

Claims 61-63, 75, 77 and 78 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over David in view of Takayama and further in view of Davis and further in view of *Electronic Payment Systems* to O'Mahony.

Each of the foregoing rejections is based in part upon David. As established above in connection with the § 102(e) rejection, Applicant has sworn back of David, and so each of these rejections should be withdrawn.

Favorable reconsideration and withdrawal of these rejections are respectfully requested.

REQUEST FOR CORRECTION OF PRIORITY INFORMATION

The PAIR record for this application contain errors in both the domestic and foreign priority claims for this case. The PAIR record correctly identifies this application as a continuation of application no. PCT/JP00/02014, filed on March 29, 2000. However, the PAIR record also shows this case claims the foreign priority of application no. PCT/JP99/04178, filed on August 2, 1999. A copy of the PAIR record is annexed as Exhibit A.

This application was filed with an executed Declaration reciting both of these domestic priority claims. A copy of that Declaration is appended as Exhibit B. The Declaration, it should be noted, does not recite a foreign priority claim.

The PAIR record is in error because foreign priority of PCT/JP99/04178 was not claimed; rather, domestic priority was claimed.

The PAIR record therefore should be altered to (1) delete the foreign priority claim and (2) include the domestic priority claim for application no. PCT/JP99/04178, filed on August 2, 1999, as a continuation thereof.

Issuance of a corrected Filing Receipt is respectfully requested.

CONCLUSION

Other than the fees for the Request for Continued Examination and Extension of Time authorized in the papers submitted herewith, no fees are believed to be due in connection with the filing of this Amendment Accompanying Request for Continued Examination.... Nevertheless, should the Commissioner now or hereafter deem any fees to be now or hereafter due, the Commissioner is authorized to charge any and all such fees to Deposit Account No. 19-4709.

Favorable consideration and prompt allowance of this application is respectfully requested. In the event that there are any questions, or should additional information be required, please contact Applicant's attorney at the number listed below.

Respectfully submitted,

/David L. Schaeffer/

David L. Schaeffer
Registration No. 32,716
Attorney for Applicant
STROOCK & STROOCK & LAVAN LLP
180 Maiden Lane
New York, New York 10038-4982
(212) 806-5400